

REMARKS

Claims 1-34 are pending. No claim is canceled, withdrawn, amended, or added. No new matter is introduced.

The final Office Action mailed March 4, 2004 rejected claim 1 under 35 U.S.C. § 102(e) as anticipated by *Watson* (U.S. Patent No. 5,991,750), claims 6, 11, 16, 21, 26, and 32 under 35 U.S.C. § 103(a) as obvious over *Watson* in view of *Walker et al.* (U.S. Patent No. 6,616,458), claims 2, 7, 12, 17, 22, and 27 under 35 U.S.C. § 103(a) as obvious over *Watson* in view of *Peters et al.* (U.S. Patent No. 5,724,584), claims 3, 4, 8, 9, 13, 14, 18, 19, 23, 24, 28, 29, 30, 33, and 34 under 35 U.S.C. § 103(a) as obvious over *Watson* in view of *Cook* (U.S. Patent No. 6,496,744), and claims 5, 10, 15, 20, 25, and 31 under 35 U.S.C. § 103(a) as obvious over *Watson* in view of *Goldband et al.* (U.S. Patent Application Publication No. US 2001/0018673). Applicant respectfully traverses the rejection of all pending claims, and requests reconsideration of the claims.

Attention is first directed to the rejection of claim 1 as anticipated by *Watson*. Claim 1 recites, “storing account information of a plurality of customers in a database, the **account information including information for associating each of the plurality of customers with a particular agent among a plurality of agents**” and “generating a list of customer accounts corresponding to the particular agent from the account information; and displaying the list via a web browser to the agent.”

By contrast, *Watson* (Per Abstract) is directed to an account processing method for providing specific pre-authorization parameters for categories of transactions that would otherwise be completely denied. Upon establishment of an account, certain categories of transactions are specified as needing specific authorization prior to approving the transaction as requested by a merchant. An account issuer provides a service to account members that permits

an account manager to independently specify the parametric conditions under which to approve a transaction within such categories.

The Office Action asserts, “Watson ‘750 discloses a method for providing an on-line billing system, the method comprising: storing account information of a plurality of customers in a database, the account information including information for associating each of the plurality of customers with a particular agent among a plurality of agents [account manager may be in charge of many accounts, col 6, lines 60-65].” (Office Action, Page 2, lines 13-18) However, the cited passage of col. 6, lines 60-65 states:

As used herein, the term "account manager" refers to an individual or organization charged with establishing and monitoring an account. An account manager may be in charge of many accounts and take the form of fleet managers, accounting managers, claims adjusters and also prudent account users.

This passage thus refers to an account manager who may establish and monitor many accounts, but does not disclose use of **“account information including information for associating each of the plurality of customers with a particular agent among a plurality of agents.”** That is, the mere existence of an account manager does not entail the use of information to associate the accounts with the account manager, particularly in the manner claimed; there is simply no factual basis for the interpretation adopted by the Office Action. In fact, in the entire specification of *Watson* there is only discussion of a singular “account manager,” and thus, never a need to associate the accounts.

The Office Action further asserts, “generating a list of customer accounts corresponding to the particular agent from the account information [Fig 5, 504, col. 7, lines 23-30]” (Office Action, Page 2, lines 19-20). The cited passage of col. 7, lines 23-30 merely provides a definition of the term “account issuer” as an organization providing administrative services to an account user and a card company or authorizing agent. The account manager may also provide

augmented services to an account user or manager such as access to an authorizing agent for account establishment and other functions such as pre-authorization.

Furthermore, with respect to this claim feature, the Office Action notes the use of a transaction identifier and the display of multiple customer accounts (per FIG. 5). However, *Watson*'s disclosure of the transaction identifier is as follows: "a transaction identifier 510 may be associated to a pre-authorized transaction generated by an account manager" (col. 12: 19-21). Col. 4: 19-35 of *Watson* also discloses that "the transaction identifier is included with the generic billing information (e.g., transaction amount, merchant information, etc.) thus allowing an account manager to reconcile their accounting from a billing account information containing the transaction having the transaction identifier associated thereto with a pre-transaction assignment of a traditional identifier such as purchase order number, work order number, or insurance claim number." Thus, the transaction identifier, as the label suggests, is associated with the transaction, not the account manager. As for FIG. 5, this merely shows the various account numbers and corresponding transaction identifiers to form a billing statement. Because the account manager can view the billing statement, the Office Action presupposes that the billing statement contains the claimed account information for **"associating each of the plurality of customers with a particular agent among a plurality of agents."** This conclusion is simply without support in *Watson*.

In addition, the Office Action states, "displaying the list via a web browser to the agent [inherent in personal computer and INTERNET, col 4, lines 61-66, Fig 5, 502]." (See Office Action, Page 2, lines 22-23) However, col. 4: 61-66 of *Watson* states:

In the present invention, once an account is established with a card issuer, an account manager may perform pre-authorization of transactions with the card issuer directly. In the preferred embodiment, an account manager using a personal computer may routinely generate pre-authorization requests by transferring pre-authorization parameters to the card issuer via the INERNET [sic].

This portion of *Watson* thus discusses an account manager that **transfers pre-authorization parameters to a card issuer via the Internet**. The general disclosure of the “Internet” is different from the specific feature of “displaying the list via a web browser to the agent” of claim 1. A single prior art reference anticipates a patent claim if it expressly or inherently describes each and every limitation set forth in the patent claim. *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). **Inherent anticipation requires that the missing descriptive material is “necessarily present,” not merely probably or possibly present, in the prior art.** *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citing *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)). There is no display of the list (e.g., the list of Fig. 5) “via a web browser to the agent” that is “necessarily present” in any of the cited portions of *Watson*, and thus claim 1 is not anticipated by *Watson*.

Further, the lack of disclosure of the claim features is consistent with the acknowledgement by the Office Action that **“Watson ‘750 fails to disclose generating a list of customer accounts corresponding to the particular agent from the account information, and to instruct display of the list via a web browser to the agent,”** with respect to the rejection of claims 6, 11, 16, 21, 26, and 32. (See Office Action, Page 3, lines 17-19)

Attention is now directed to the rejection of claims 6, 11, 16, 21, 26, and 32 as obvious over *Watson* in view of *Walker et al.* As discussed above, *Watson* does not disclose “account information including information for associating each of the plurality of customers with a particular agent **among a plurality of agents,**” and *Walker et al.* does not cure the deficiencies of *Watson* in this regard (i.e., “a controller such as an online service provider or an ISP

computer” does not satisfy the recited “particular agent among a plurality of agents” as recited by claim 6).

Walker et al. discloses a method and apparatus for administering a survey, whereby a **controller** such as an online service provider **computer** or an ISP **computer** receives a survey including survey questions from a client desiring to have a survey conducted. (Abstract) The **controller** creates respondent questions based on the survey questions. The **controller** also selects one or more respondents from a list of possible respondents, such as a list of customer accounts. The respondent questions are transmitted to the selected respondents. Responses corresponding to the respondent questions are received. The **controller** applies an inconsistency test to the responses to generate an inconsistency test result. The inconsistency test determines if the responses originate from computers or humans not paying attention to the questions. Based on the inconsistency test result, a fraud signal may be generated. The fraud signal may result in several actions, such as the **controller** ignoring the responses received from the corresponding respondent, reducing or eliminating payment to the respondent, transmitting a message of reprimand to the respondent, and/or barring the respondent from future participation in surveys. (Per Abstract, emphasis added)

The Office Action’s assertion that “both Watson and Walker disclose the Internet and a web browser” is simply not true, as neither reference discloses a “web browser,” and one skilled in the art would not be motivated to display a list of customers to the controller (i.e., computer) of *Walker et al.* via a web browser.

Moreover, one of ordinary skill in the art of data processing would not be motivated by this disclosure of *Walker et al.* to instruct **display** of the list of customer accounts to the controller (i.e., a **computer**) **via a web browser**, as the controller of *Walker et al.* is a **computer** which receives a survey and may select respondents from a list of customer accounts for

transmittal of respondent questions, and thus, would not need to display anything. Accordingly, *Walker et al.* teaches **away** from combining its disclosure with *Watson* for the feature “a processor coupled to the communication interface and configured to generate a list of customer accounts corresponding to the particular agent from the account information, and to instruct **display of the list via a web browser to the agent**” as required by claim 6.

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 218 USPQ 769 (Fed. Cir. 1983). A prior art reference must be considered in this entirety including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Thus, Applicant respectfully requests withdrawal of the rejection with respect to independent claim 6.

For reasons similar to those stated previously with regard to claims 1 and 6, Applicant additionally submits that the rejection of independent claims 11, 16, 21, 26, and 32 should be withdrawn.

With regard to the obviousness rejections of claims 2, 7, 12, 17, 22, and 27, Applicant respectfully submits that the deficiencies of *Watson* are not cured by the secondary reference of *Peters et al.*, particularly with respect to “account information including information for associating each of the plurality of customers with a particular agent among a plurality of agents; generating a list of customer accounts corresponding to the particular agent from the account information; and displaying the list via a web browser to the agent.” Applicant respectfully submits that, in its rejection of independent claims 6, 11, 16, 21, 26, and 32, the Office Action specifically states, “*Watson* ‘750 **fails to disclose** generating a list of customer accounts corresponding to the particular agent from the account information, and to instruct display of the

list via a web browser to the agent.” (Office Action, Page 3, lines 17-19) In its rejection of claims 2, 7, 12, 17, 22, and 27, the Office Action asserts, “Watson ‘750 discloses the elements of claims 1, **6, 11, 16, 21 and 26 as noted above.**” There is no mention of how either of *Watson* or *Peters et al.* suggests or discloses the feature which the Office Action previously acknowledged was **not** disclosed by *Watson* until the “Response to Arguments” section, in which *Watson* col. 4: 19-35 and col. 4: 60-67 are cited. As discussed previously, these portions of *Watson* do not suggest or disclose the claimed features.

Peters et al. is directed to a method for processing discrete billing events related to batch processing of customer account information in order to perform periodic customer billing. (Abstract and col. 1, lines 22-24) Applicant respectfully submits that neither of the references individually, nor in any reasonable combination, suggests or discloses the missing features previously discussed with regard to independent claims 1, 6, 11, 16, 21, and 26, from which each of claims 2, 7, 12, 17, 22, and 27, respectively, depend. Thus, Applicant respectfully requests that the rejection of these claims be withdrawn.

Similarly, with regard to the obviousness rejections of claims 3, 4, 8, 9, 13, 14, 18, 19, 23, 24, 28, 29, 30, 33, and 34, Applicant respectfully submits that the addition of *Cook* does not fill in the gaps of *Watson* discussed previously. *Cook* is directed to a system for selling, manufacturing and distributing a custom digital data product from retail stores, over the Internet, over the telephone, or by electronic means (e.g., fax, e-mail, and the like) wherein a **customer is provided (e.g., by electronic mail verification) order tracking information.** Throughout manufacture and distribution, the **customer may track the process by activating a hyperlink in one or more e-mail confirmation messages provided by the service provider,** or by entering order/tracking numbers from retail terminals or by telephone, or the like. (Abstract) There is no mention or suggestion in *Cook* of “generating a list of customer accounts

corresponding to the particular agent from the account information; and displaying the list via a web browser **to the agent.**” As discussed previously, there is no mention or suggestion of this feature in *Watson*. Applicant respectfully submits no reasonable combination of *Watson* and *Cook* suggests or discloses this feature. Further, there is no suggestion or disclosure of “providing automatic receipt of an e-mail notification message to **notify one of the plurality of agents** of an event associated with the customer, wherein **the event includes at least one of a new enrollment and an account cancellation,**” as *Cook* is directed to e-mail notification to a customer verifying that an order has been accepted for processing or that the order has been shipped. (col. 3: 32-48)

With regard to the Office Action’s assertion of a motivation (Office Action, page 5, lines 10-21) to modify *Watson* “for the purpose of improving the invention by **providing a customer with order process updates** so that the customer can plan to receive the product,” Applicant respectfully submits that, for example, claim 3 recites, “providing automatic receipt of an e-mail notification message **to notify one of the plurality of agents** of an event associated with the customer, wherein **the event includes at least one of a new enrollment and an account cancellation.**” If the Office Action is equating the “account manager” of *Watson* with the recited “agent” of claim 3, then the Office Action fails to explain how *Watson* is to be modified, with this asserted motivation, to meet the features of claim 3. *Cook* is directed to providing a customer “(e.g., by electronic mail verification) **order tracking information,**” and *Watson* is directed to an account issuer permitting an **account manager** to independently specify the parametric conditions under which to approve a transaction within certain categories such that the account manager may also specify a transaction identifier such as a purchase order, work order or insurance claim number to associate with the required transaction parameters. Upon the approval of such a transaction requiring specific authorization, the authorizing agent during the

billing process forwards both the transaction-specific information such as transaction amount and merchant information with the transaction identifier as previously assigned by the account manager.

Obviousness rejections require some evidence **in the prior art** of a teaching, motivation, or suggestion to combine and modify the prior art references. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). The Office Action has shown no such evidence.

Additionally, Applicant respectfully submits that both *Cook* and *Watson* are directed to non-analogous art. “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of the applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992); see also *In re Clay*, 966 F.2d 656 (Fed. Cir. 1992) (“A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.”).

Thus, the rejection of claims 3, 4, 8, 9, 13, 14, 18, 19, 23, 24, 28, 29, 30, 33, and 34 should be withdrawn.

With regard to the obviousness rejections of claims 5, 10, 15, 20, 25, and 31, Applicant respectfully submits that the secondary reference of *Goldband et al.* similarly does not relieve the shortfalls of *Watson*. *Goldband et al.* is directed to broad-based, systematic, individualized, interactive customer software support through a two-way, voluntary automated exchange of information between a **software agent installed on a customer's machine** and a server machine

via a wide area computer network, e.g., the Internet. The agent, with the user's informed consent, gathers activity information about the operations of the software program(s) on a single machine and uploads this information to a particular server machine within a distributed server machine architecture, where it is stored in a database on a per-software-copy basis. A rules engine may cause instructions carrying a message targeted specifically toward the customer (based on the activity information) to be downloaded to the agent. Based on these instructions, the agent may take any of various actions, such as present a survey, present an advertisement, send an upgrade notice, present a limited-time offer, deliver individualized marketing messages, offer goods for sale and fulfill the commercial transaction, install an upgrade or bug fix for either an application or the agent itself, etc. Message presentation **to the customer** may be timed (e.g., delayed from the time of download) to achieve maximum impact. For example, a message relating to a particular product feature may be presented just after that feature has been used. (Abstract, emphasis added) There is no mention or suggestion in *Goldband et al.* of “generating a list of customer accounts corresponding to the particular agent from the account information; and displaying the list via a web browser to the agent.” As discussed previously, there is no mention or suggestion of this feature in *Watson*. Applicant respectfully submits no reasonable combination of *Watson* and *Goldband et al.* suggests or discloses this feature.

Claim 5 recites “the customer account in the storing step is associated with a user identification of the particular agent.” The Office Action (page 7, lines 3-9) acknowledges that *Watson* fails to disclose this feature, and thus, relies on *Goldbrand et al.* The cited portion of *Goldband* states (paragraph 33):

The Inet plug-in is responsible for handling all Internet traffic. In an exemplary embodiment, it supports various types of Internet transactions, including **registering an agent with the server and obtaining a user ID**, retrieving a command file using the user ID, uploading data to the server, and downloading resources from the server. Data may be exchanged using POST and

GET commands, for example, as in the HTTP1.1 protocol. The Inet plug-in is designed to gracefully fail if any transaction is not completed across the Internet.

The Office Action fails to explain how the registration of an agent with a server in *Goldband* relates to the “account manager” of *Watson*. As best understood, the Office Action equates the recited “customer” with the account user 104 of *Watson*, and the recited “agent” with the account manager 102. Applicant has carefully studied *Watson*, and can find no explanation whatsoever for how “wherein the customer account in the storing step is associated with a user identification of the particular agent as taught by Goldbrand ‘673” achieves any purpose of “uniquely identifying the user.” In fact, observing Fig. 5, which was cited by the Office Action in its rejection of previously discussed claims, the “Account Number” field appears to have already achieved at least this purpose, and thus there would be no motivation for modification. Obviousness rejections require some evidence in the prior art of a teaching, motivation, or suggestion to combine and modify the prior art references. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Therefore, the rejection of claims 5, 10, 15, 20, 25, and 31 should be withdrawn.

Therefore, the present application is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at 703-425-6499 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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